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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,685	03/23/2000	Michael Lee Hearn	600.1040	9876

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NEW YORK, NY 10018

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

18

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/533,685

Applicant(s)

Hearn

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 3, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-17, 20, and 21 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 10-14, 16, and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-9, 15, 20, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on March 3, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/533,685 is acceptable and a CPA has been established. An action on the CPA follows.
2. The amendment filed March 3, 2003 has been entered. It is noted that in view of the amendment practice under 37 CFR 1.121 which became effective for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

### ***Claim Rejections - 35 USC § 112***

3. Claims 1, 3, 5-9, 15, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, line 5, “the at least one of the first and second cutting surfaces” lacks positive antecedent basis, and it is suggested to delete “the” before “at least” or the like.

In claim 7, line 2, “a two-part metallic hub” is vague and indefinite as to how it relates to the second cutting cylinder and the second anvil cylinder set forth in claim 1, and it is suggested in line 1 to change “the second cutting and nipping device” to --at least one of the second cutting cylinder and the second anvil cylinder-- or the like.

In claim 20, line 4, “the at least one of the first and second cutting surfaces” lacks positive antecedent basis, and it is suggested to delete “the” before “at least” or the like.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5-9, 15, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al., pn 5,740,709, in view of Palmatier et al., pn 5,107,733 and Littleton, pn 5,103,703.

Boston discloses a device with almost every structural limitation of the claimed invention including a first cutting and nipping device having a first cutting cylinder (e.g., 160) and a first

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anvil cylinder (e.g., 162); and a second cutting and nipping device downstream of the first cutting and nipping device, the second cutting and nipping device having a second cutting cylinder (e.g., 164) and a second anvil cylinder (e.g., 166), wherein the second cutting cylinder has two segmented cutting elements or axially extending cutting surfaces (e.g., 150) spaced 180° apart, and has a second nipping cylinder surface extending circumferentially with respect to the cutting edges, wherein the second nipping cylindrical surface interacts with the second anvil cylinder to provide a second nip.

Boston lacks the first cutting cylinder having a first nipping surface as claimed that interacts with the first anvil cylinder to provide a first nip. However, the Examiner takes Official notice that such cutting cylinder configurations are old and well known in the art and provide various well known benefits including providing a more secure and uniform grip on the workpiece to better pull it through the cutting device. As one example, Palmatier et al. discloses an example of such a cutting cylinder configuration and teaches that the configuration, among other things, provides an apparatus which assures correct and position-exact transporting of a web in a printing press. Therefore, it would have been obvious to one having ordinary skill in the art to provide a first cutting cylinder and first anvil cylinder configuration such as that taught by Palmatier in the apparatus of Boston for the well known benefits including those described above.

Regarding claims 5, 6 and 8, Palmatier teaches the use of outer cylinder coatings made of rubber or synthetic material, and thus lacks the specific disclosure of the use of urethane.

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However, the Examiner takes Official notice that the use of urethane on cutting and/or anvil cylinder surfaces is old and well known and provides various benefits including the particular characteristics thereon, and further is a well known equivalent to rubber. Littleton provide example of such a use for urethane as a cylinder coating. Therefore, it would have been obvious to one having ordinary skill in the art to select urethane as the specific type of “synthetic material” used in Palmatier to gain the well known benefits thereof.

Regarding claims 7 and 15, the combination of Boston in view of Palmatier teaches or suggests an apparatus with almost every structural limitation of the claimed invention but lacks (a) a two-part metallic hub including a urethane layer bonded to the outer surface of the hub; and (b) the segmented cutting element bolted to the hub of the cutting cylinder.

Regarding (a), the Examiner takes Official notice that it is old and well known to provide a two-part metallic hub, and further to coat such a hub with urethane. In particular, the Examiner takes Official notice that it is old and well known in the art to form hubs in various configurations regarding number of parts thereof to facilitate assembly, maintenance or other well known design configurations. Further, for the reasons described above, it is old and well known in the art to provide an outer coating of urethane on cylinder hubs. Therefore, it would have been obvious to one having ordinary skill in the art to provide a two-part metallic hub, and further to coat such a hub with urethane for the well known benefits including those described above.

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Regarding (b), the Examiner takes Official notice that it is old and well known in the art to bolt the segmented cutting element to the hub of the cutting cylinder. For example, Littleton discloses a cutting apparatus wherein the cutting knives are bolted to the hub. Such a configuration provides various well known benefits including simple removal and replacement of the cutting knives as well as inexpensive structure for reliably and releasably connecting the knives to the hub. Therefore, it would have been obvious to one having ordinary skill in the art to bolt the segmented cutting element to the hub of the cutting cylinder in the device of Boston for the well known benefits including those described above.

### ***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers Technology Center 3700 are: after-final responses - (703)872-9303; other formal/official papers - (703)872-9302. The fax number for informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
May 19, 2003